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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/982,211

10/17/2001

James Shuder

SUN-P6552 US/NC

7395

7590

10/11/2005

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EXAMINER

JASMIN, LYND A C

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/982,211

Applicant(s)

SHUDER ET AL.

Examiner

Lynda Jasmin

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. Applicant's arguments, see paper mailed July 13, 2005 with respect to the last Office action have been fully considered and are partially persuasive. The finality of that action has been withdrawn.

#### ***Claim Rejections - 35 USC § 101***

2. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claim 1, the system contains software (data) structures not claimed as embodied in computer-readable media and therefore are descriptive material *per se* and are not statutory because they are not capable of causing function change in a computer. See *In re Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760. A claim must define a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, to define a statutory product.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Haney (2001/0051889 A1).

Haney discloses the system and method (10) as claimed having a computer implemented procurement module (via organization 20) for processing both purchase order requisitions for goods and timecard information for services (see page 2, ¶ [0021]), the procurement module including a buyer module (via requesting manager computer 22) for receiving information related to contractor services (via candidate's services) and for generating an electronic timecard in response thereto (see page 2, ¶ [0022]), and a timecard module (via contract computer 28) receiving electronic timecards from the buyer module and for generating a purchase order based on approved electronic timecards (¶ [0025]), the purchase order for use in generating a payment for the contractor services (via submitting an invoice to organization 20).

Haney further discloses a workflow module (via estimated work hours and overtime hours) coupled to the timecard module for use in allowing an approver (resource approver) to approve and decline the electronic timecards (see ¶ [0025]). Further, the timecard module generates an approval notification in response to receiving an electronic timecard from the buyer module (see ¶ [0026]). The approval notification is an electronic mail message having an approval form readable by the workflow module (via a CLR form), the electronic mail message transmitted to an approver related to the contractor services (see ¶ [0026]). The approval form is readable by an electronic mail program and is returned to the computer implemented procurement system after being completed by the approver (see ¶s [0028-0031]). The buyer module

is browser based (GUI) and wherein the procurement module is hosted on a remote server system (via communication network 30). The computer implemented procurement system (via organization 20) further includes an external report generating module for generating information to be used by external applications and wherein the information is formatted using XML data (see ¶ [0036]). The electronic timecard further includes a plurality of line items describing the contractor services (via presenting resumes information) having a contractor identification, a description of services rendered, an amount of hours performed for the services rendered, an hourly rate for said hours, and subtotals representing the amount of hours by the hourly rate (as illustrated in Figure 6). The timecard module includes a contractor profile for a contractor, the contractor profile including contractor identification, authorized projects for the contractor, authorized work types for the contractor, an authorized hourly rate for the contractor, and an approver for the contractor (as illustrated in Figure 4; see ¶s [0049-0051]). The electronic timecard comprises a plurality of line items and wherein the approval notification comprises information from the electronic timecard and an accounting code associated with each line time of said electronic timecard (via field 614-616; as illustrated in the timesheet form Figure 6).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huff et al. (4,383,298).

Huff et al. discloses the system and method as claimed having a system comprising: a computer implemented procurement module (via online CRT "smart" terminals 50) for processing both purchase order requisitions for goods and timecard information for services, the procurement module including a buyer module for receiving information related to contractor services and for generating a timecard in response thereto (via maintenance analysis system; col. 6, line 46 through col. 7, line 10), and a timecard module receiving timecards from the buyer module and for generating a purchase order based on approved timecards, the purchase order for use in generating a payment for the contractor services (via SUBMOD that generates labor time card, purchase orders, the repair history cards, the actual job scheduling and working being indicated in stage 20 in the flow chart of FIG. 1).

Although Huff does not explicitly disclose generating an electronic timecard, Huff discloses that his system provide online editing and updating with respect to activity and maintenance request order. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided an electronic timecard since the system of Huff permits an online inquiry capability.

### ***Response to Arguments***

8. Applicant's arguments filed November 16, 2004 have been fully considered but they are not partially persuasive.

Applicants first argue, "Huff does teach a computer implemented procurement module ... *for generating an electronic timecard...*" and "for generating a purchase order based on approve electronic timecards." The Examiner notes although Huff does not explicitly disclose generating an electronic timecard, Huff discloses that his system provide online editing and updating with respect to activity and maintenance request order. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided an electronic timecard since the system of Huff permits an online inquiry capability.

Applicants further argue, "The timecards mentioned in Huff (e.g., col. 6, line 4-11) appear to be physical (i.e. paper) timecards. Huff teaches that information from physical time may be entered into the database complex for use by a maintenance analyst in analyzing new maintenance request (col. 6, lines 24-45)." The Examiner

respectfully disagrees. Nowhere in Huff does a physical (i.e. paper) time cards being mentioned.

Applicants next argue, "Haney does not teach a computer implemented procurement module for processing both purchase order requisitions for goods and timecard information for services." The Examiner respectfully disagrees. It is the Examiner's position that when interpreting functional language, if the prior art is capable of performing the claimed function --even if not directly disclosed-- it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (Applicant's popcorn dispenser was rejected with an oil can because the functional limitations were inherent in the reference). It is well known that the Applicants are free to recite features of an apparatus either structurally or functionally. *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971). It is the Examiners position that the limitations "for goods" and "for services" are functional or intended use language. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the function or intended use, then it meets the claim. *In re Casey*, 370 F.2d 576, 152 USPQ 235, 238 (CCPA 1967).

If Applicants desire to give the phrase greater patentable weight, the Examiner respectfully recommends Applicants remove "for" from the phrase where intended use is not desired. Like always, such amendments must not constitute new matter and must be supported in Applicants' specification.

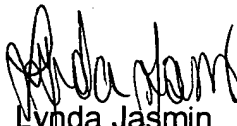


Applicants further argue "Haney does not teach generating information to be used by external applications wherein the information is formatted using XML data." The Examiner respectfully disagrees. Haney discloses using the help of a web browser such as Internet Explorer 4.0 or Netscape Navigator 4.0 to present information to present information, a variety of other manners, such as fax or mail to send information. The Examiner notes that web browser is software that lets a user view HTML documents. HTML and XML are markup languages, which are used in web pages.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (571) 272-6782. The examiner can normally be reached on Monday- Friday (9:30-6:00) with Thursday Telework.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Lynda Jasmin  
Primary Examiner  
Art Unit 3627